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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 972,805	10 05 2001	Vicki L. Chandler	416272061200	6794

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MORRISON & FOERSTER LLP  
425 MARKET STREET  
SAN FRANCISCO, CA 94105-2482

EXAMINER

MEHTA, ASHWIN D

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 09 12 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/972,805

Applicant(s)

CHANDLER ET AL.

Examiner

Ashwin Mehta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-380 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-380 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-545)
- 3) ☐ Notice of Substantive Examination (PTO-891)
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Foreign Priority Documents (PTO-893)

***Restriction/Election***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-28, 35-40, 181-220, 281-320, drawn to a mutant mop1-1, mop1-2EMS, mop1-4, and mop1-5 corn plant, where upon propagation a change in gene activity of a paramutable allele of said plant due to its exposure to a paramutagenic allele is reduced, or comprising a hypomethylated Mu1 element; or seed that produce said mutant plant; or tissue culture of regenerable cells of said plant; or seed or progeny produced from said plant, classified in class 435, subclass 410, for example.
- II. Claims 1-28, 35-39, 121-140, drawn to a mutant mop2-1 corn plant, where upon propagation a change in gene activity of a paramutable allele of said plant due to its exposure to a paramutagenic allele is reduced, or comprising a hypomethylated Mu1 element; or seed that produce said mutant plant; or tissue culture of regenerable cells of said plant; or seed or progeny produced from said plant, classified in class 800, subclass 295, for example.
- III. Claims 1-3, 4-13, 15, 17-20, 22-26, 28, 35-39, 61-80, and 341-360, drawn to a mutant rmr1-1 or rmr1-2 corn plant, where upon propagation a change in gene activity of a paramutable allele of said plant due to its exposure to a paramutagenic allele is reduced, or comprising a hypomethylated Mu1 element;

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said plant; or seed or progeny produced from said plant, classified in class 800, subclass 298, for example.

- IV. Claims 1-3, 4-13, 15, 17-20, 22-26, 28, 35-39, and 81-100, drawn to a mutant *rmr2-1* corn plant, where upon propagation a change in gene activity of a paramutable allele of said plant due to its exposure to a paramutagenic allele is reduced, or comprising a hypomethylated *Mu1* element; or seed that produce said mutant plant; or tissue culture of regenerable cells of said plant; or seed or progeny produced from said plant, classified in class 800, subclass 320.1, for example.
- V. Claims 1-3, 4-13, 15, 17-20, 22-26, 28, 35-39, 211-240, drawn to a mutant *rmr6-1* corn plant, where upon propagation a change in gene activity of a paramutable allele of said plant due to its exposure to a paramutagenic allele is reduced, or comprising a hypomethylated *Mu1* element; or seed that produce said mutant plant; or tissue culture of regenerable cells of said plant; or seed or progeny produced from said plant, classified in class 435, subclass 412, for example.
- VI. Claims 1-3, 4-13, 15, 17-20, 22-26, 28, 35-39, 261-280, drawn to a mutant *rmr8-1* corn plant, where upon propagation a change in gene activity of a paramutable allele of said plant due to its exposure to a paramutagenic allele is reduced, or comprising a hypomethylated *Mu1* element; or seed that produce said mutant plant; or tissue culture of regenerable cells of said plant; or seed or progeny

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- VII. Claims 1-3, 4-13, 15, 17-20, 22-26, 28, 35-39, 241-260, drawn to a mutant *rmr11-1* corn plant, where upon propagation a change in gene activity of a paramutable allele of said plant due to its exposure to a paramutagenic allele is reduced, or comprising a hypomethylated *Mu1* element; or seed that produce said mutant plant; or tissue culture of regenerable cells of said plant; or seed or progeny produced from said plant, classified in class 800, subclass 260, for example.
- VIII. Claims 1-3, 4-13, 15, 17-20, 22-26, 28, 35-39, 101-120, 141-160, drawn to a mutant *rmr7-1* or *rmr7-2* plant, where upon propagation a change in gene activity of a paramutable allele of said plant due to its exposure to a paramutagenic allele is reduced, or comprising a hypomethylated *Mu1* element; or seed that produce said mutant plant; or tissue culture of regenerable cells of said plant; or seed or progeny produced from said plant, classified in class 800, subclass 275, for example.
- IX. Claims 1-3, 4-13, 15, 17-20, 22-26, 28, 35-39, 361-380, drawn to a mutant *rmr9-1* corn plant, where upon propagation a change in gene activity of a paramutable allele of said plant due to its exposure to a paramutagenic allele is reduced, or comprising a hypomethylated *Mu1* element; or seed that produce said mutant plant; or tissue culture of regenerable cells of said plant; or seed or progeny produced from said plant, classified in class 800, subclass 266, for example.
- X. Claims 1-3, 5-10, 12-15, 17-20, 22-28, 35-39, 161-180, drawn to a mutant *mop3-* allele of said plant due to its exposure to a paramutagenic allele is reduced, or

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comprising a hypomethylated Mu1 element; or seed that produce said mutant plant; or tissue culture of regenerable cells of said plant; or seed or progeny produced from said plant, classified in class 800, subclass 268, for example.

XI. Claims 1-3, 5-10, 12-15, 17-20, 22-28, 35-39, 321-340, drawn to a mutant CC2343 corn plant, where upon propagation a change in gene activity of a paramutable allele of said plant due to its exposure to a paramutagenic allele is reduced, or comprising a hypomethylated Mu1 element; or seed that produce said mutant plant; or tissue culture of regenerable cells of said plant; or seed or progeny produced from said plant, classified in class 800, subclass 267, for example.

XII. Claims 29-34 and 41-60, drawn to a mutant corn plant comprising one or more mutations causing an increase in expression of a transgene as compared to expression in a non-mutant transgenic corn plant; a process of producing a transgenic corn plant with an activated transgene, comprising crossing a transgenic corn plant with a mutant corn plant in which the maintenance or establishment of paramutation is reduced; transgenic corn plants produced by said process; seed of said transgenic plant, classified in class 435, subclass 468, for example.

Claims 1-28 and 35-39 link(s) inventions I-XI. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-28 and 35-39.

inventions shall be withdrawn and any claim(s) depending from or otherwise including any the

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limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

Each of inventions I-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions modes of operation and functions. Each of the groups comprises mutant corn plants having mutations in different genes. Different nucleotide genes are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each mutant is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

Each of inventions I-XI and XII are unrelated. Inventions are unrelated if it can be operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the

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instant case the different inventions functions and effects. The non-transgenic plants, tissue cultures, and plant parts of Groups I-XI do not require the method and transgenic plants and plant parts of Group XII. The expression of the transgenes in the plants of Group XII provides those plants with properties that are not expressed by the non-transgenic plants of Groups I-XI.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for each of Groups II-XII, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Contact Information***

Any inquiry concerning this or earlier communications from the examiner should be directed to Ashwin Mehta, whose telephone number is 703-306-4540. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays from 8:00 A.M to 5:30 P.M.

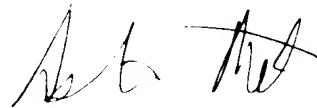
Nelson, can be reached at 703-306-5218. The fax phone numbers for the organization where this



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application or proceeding is assigned are 703-305-3014 and 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

September 4, 2003

A handwritten signature in black ink, appearing to read 'Ashwin D. Mehta', is positioned above the printed name.

Ashwin D. Mehta, Ph.D.  
Primary Examiner  
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